

31 MAR 2000



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In re Application of	:	
Klockseth et al.	:	DECISION ON
Application No. 09/367666	:	
PCT No.: PCT/AU98/00099	:	PETITION UNDER
Int. Filing Date: 18 February 1998	:	
Priority Date: 18 February 1997	:	37 CFR 1.47(a)
For: Pressure Compensating Valve	:	

This is a decision on the petition under 37 CFR § 1.47(a) filed on 06 March 2000.

**BACKGROUND**

This international application was filed on 18 February 1998, claiming priority of an earlier application filed on 18 February 1997. A Demand electing the United States was filed on 10 September 1998, which was prior to the elapse of 19 months from the priority date. The International Bureau transmitted a copy of the published international application to the United States Patent and Trademark Office on 27 August 1998. Accordingly, the 30 month time period for paying the basic national fee in the United States expired as of midnight on 18 August 1999.

On 17 August 1999, applicants filed a Transmittal Letter for entry into the national stage in the United States. The Transmittal Letter was not accompanied by, *inter alia*, the required basic national fee and an unsigned declaration of the inventors.

On 03 November 1999, a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) was transmitted to applicant, indicating *inter alia* that "the current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917." The Notification of Missing Requirements further required the submission of a surcharge under 37 CFR 1.492(e). Indicating that A Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) was transmitted therewith, indicating that the "oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it is not executed in accordance with 37 CFR 1.66 or 37 CFR 1.68."

On 06 March 2000, applicants filed the instant petition under 37 CFR 1.47(a), along with, *inter alia*, a petition and fee authorization for a three month extension of time under 37 CFR 1.136(a) and a declaration signed by inventor Goran Bertil Claes Berndtsson.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Petitioner has satisfied requirements (1), (3) and (4).

With respect to requirement (2), petitioner suggests that the reason for the absence of the signatures of joint inventors Mr. Jervmo and Mr. Klockseth is that they refuse to execute the declaration and/or could not be found or reached, but does not provide an adequate showing that they "refuse to join" in the application or "cannot be found or reached after diligent effort" within the meaning of 37 CFR 1.47(a). Petitioner alleges that "Attempts have been made to have Mr. Bengt Jervmo and Mr. Oliver Klockseth execute the declaration. They have not responded." In support of this assertion, petitioner states that "Copies of the patent application and the Declaration were forwarded to each of them at their last known addresses on August 30, 1999, but were never returned. Repeated efforts to have the signed Declarations returned have been unsuccessful." These statements are insufficient because it is not clear that they are made by a person having first-hand knowledge of the events recounted. Moreover, only the August 30, 1999 mailing is specifically identified. If possible, specific facts underlying the assertion that "Repeated efforts to have the signed Declarations returned have been unsuccessful" should be provided. Also, copies of any available documentary evidence, such as certified mail return receipts, cover letters, or telegrams should be provided. Further discussion of the character of the evidence required may be found at MPEP 409.03(d). Based on the evidence currently of record, it would be inappropriate to grant the requested relief.

### **DECISION**

For the reasons explained *supra*, the petition is **DISMISSED**, without prejudice.

**Petitioner's Deposit Account 20-1430 is being charged in the following amounts, as authorized by the papers filed on 06 March 2000: (1) \$130.00 (fee code 122); (2) \$130.00 for the surcharge under 37 CFR**

**1.492(e) (fee code 154); and (3) \$870.00 for a three month extension of time under 37 CFR 1.136(a)(fee code 117).**

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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